

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed October 5, 2006. Claims 13-32 were previously cancelled without prejudice or disclaimer due to an election/restriction requirement. Claim 9 was previously cancelled without prejudice or disclaimer and Claims 1-8, 10-12, 33 and 34 are pending in this Application. Claims 1-3 and 5-11 stand rejected under 35 U.S.C. § 112, Claims 1-8 and 10-12 stand rejected under 35 U.S.C. § 103(a), and the Examiner has not indicated any disposition of Claims 33 and 34. Claims 1 and 8 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1-3 and 5-11 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner alleges that because claims recite a reference mirror "replacing" a reference objective, it is unclear how the reference mirror replaces the reference object. Applicants have amended Claim 1 and 8 to recite a reference mirror that eliminates "the need for a reference objective." Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 112, second paragraph and full allowance of Claims 1-3 and 5-11 as amended.

Rejections under 35 U.S.C. § 103

Claims 1-3 and 5-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0145773 by Satoru Tanaka et al. ("*Tanaka*").

Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tanaka* as applied to Claims 1 and 8 above, and further in view of U.S. Patent No. 6,781,725 issued to Marko Zgonik ("*Zgonik*").

Tanaka discloses a hologram recording method and an optical information recording and reproducing apparatus utilizing the holographic memory. A rotatable plane mirror is arranged on an opposite side of a recording medium from a recording reference light beam.

(Paragraph 82). At a reproducing time, the plane mirror is fixed such that the mirror is opposed to the recording reference light beam passing through the recording medium and at a recording time, the plane mirror is rotated such that the recording reference light beam is guided to a light absorber. (Paragraph 82).

Zgonik discloses a storage method and system for storing mutually non-overlapping volume holograms.

Claim 1, as amended, recites “a reference mirror located at a waist of the reference beam to eliminate the need for a reference objective on a reference arm.”

Claim 8, as amended, recites a method comprising the step of “reflecting the portion of the reference beam from a reference mirror located at the waist of the reference beam, the reference mirror eliminating the need for a reference objective on a reference arm.”

Applicants respectfully submit that the cited reference fails to disclose every element of Applicants’ invention as amended. *Tanaka* fails to teach at least a direct-to-digital holography system comprising “a reference mirror located at a waist of the reference beam to eliminate the need for a reference objective on a reference arm,” as recited by amended Claim 1. Additionally, *Tanaka* fails to teach a method for acquiring a complex image in a direct-to-digital holography system including the step of “reflecting the portion of the reference beam from a reference mirror located at the waist of the reference beam, the reference mirror eliminating the need for a reference objective on a reference arm,” as recited by amended Claim 8.

The Examiner acknowledges that *Tanaka* does not expressly disclose eliminating “the need for a reference objective on a reference arm” but argues that “the intention of using a reference mirror to replace a reference objective does not further define the structure of the system.” (Office Action, Page 3) (emphasis in original). Claims 1 and 8, however, do not express an intention but recite that the reference mirror eliminates “the need for a reference objective on a reference arm.” (emphasis added). *Tanaka* does not expressly or inherently disclose this limitation.

For at least the reasons set forth above, *Tanaka* fails to disclose the recited limitations and cannot render obvious Claims 1 and 8. Given that Claims 2-7 depend from Claim 1, and Claims 10-12 depend from Claim 8, Applicants respectfully submit that Claims 2-7 and 10-12 are allowable. As such, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103(a) and allow Claims 1-8 and 10-12.

Disposition of Claims 33 and 34

In the Office Action, the Examiner does not indicate or discuss any disposition of Claims 33 and 34. However, while the Applicants make no concessions regarding Claims 33 and 34, Applicants submit that Claims 33 and 34 are allowable because they provide further patentable limitations to Claim 8, shown to be allowable above. Accordingly, Applicants respectfully request that the Examiner allow Claims 33 and 34.

In addition, because the Examiner did not formally reject Claims 33 and 34, or provide any reasons for rejection of Claims 33 and 34 in the Office Action, Applicants submit that the Office Action was not properly made final under M.P.E.P. § 706.07(a). Accordingly, Applicants submit that the final rejection is premature, and the finality of the Office Action should be withdrawn pursuant to M.P.E.P. § 706.07(c) and (d).

Request for Continued Examination (RCE)

Applicants respectfully submit herewith a Request for Continued Examination (RCE) Transmittal and authorize the Commissioner to charge the filing fee of \$395.00 to Deposit Account No. 50-2148 of Baker Botts L.L.P.

Information Disclosure Statements

Applicants would like to bring to the Examiner's attention that the Examiner made no indication that the References submitted with Information Disclosure Statement and PTO Form 1449 filed on September 12, 2003, had been considered in Office Actions mailed March 14, 2006 and October 5, 2006. Applicants respectfully request confirmation of the consideration of the References. Applicants attach a copy of the PTO Form 1449 that was attached to the Office Action mailed March 14, 2006, and respectfully request that the Examiner place his initials next to the References if citation is to be considered or draw a line through the citation if the citation is not to be considered.

CONCLUSION

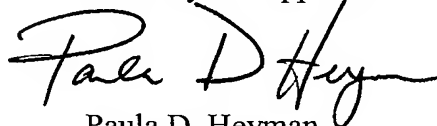
Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration of the rejections and full allowance of Claims 1-8, 10-12, 33 and 34, as amended.

Applicants respectfully submit herewith a Petition for a 3-Month Extension of Time and hereby authorize the Commissioner to charge \$510.00 for this fee to Deposit Account No. 50-2148 of Baker Botts L.L.P. In addition, Applicants authorize the Commissioner to charge \$395.00 for the Request for Continued Examination fee. Applicants believe no additional fees are due, however the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorney for Applicants



Paula D. Heyman
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Date: April 4, 2007

SEND CORRESPONDENCE TO:

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Enclosures: 1) Copy of PTO 1449 Forms filed with IDS on 9/12/03 and 4/2/04.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Clarence E. Thomas, et al.
Date Filed: September 12, 2003
Title: *Optical Acquisition Systems for Direct-to-Digital
Holography and Holography*

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this Information Disclosure Statement is being deposited with the United States Postal Service as Express Mail No. EV341125873US addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Shannon Judice
Shannon Judice

9/12/03
Date

Dear Sir:

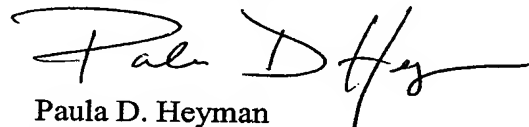
INFORMATION DISCLOSURE STATEMENT

Applicants respectfully request, pursuant to 37 C.F.R. §§1.56, 1.97 and 1.98, that the references listed on the attached PTO-1449 form be considered and cited in the examination of the above-identified application. Since the present Application was filed after June 30, 2003, a copy of any U.S. Patent and any U.S. Patent Application Publication cited on the attached PTO Form 1449 is not being submitted with this Information Disclosure Statement pursuant to the July 11, 2003 waiver of 37 C.F.R. § 1.98(a)(2)(i) by the U.S. Patent and Trademark Office.

Applicants believe no fees are due, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants


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Date: Sept 12, 2003

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PTO-1449			Application No. Not yet assigned		Applicant(s) Clarence E. Thomas, et al.		
Information Disclosure Citation in an Application			Docket Number 068062.0168		Group Art Unit Not Yet Assigned		Filing Date September 12, 2003
U.S. PATENT DOCUMENTS							
		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE
	A	6,525,821	02/25/03	Thomas et al.	356	457	01/04/00
	B	6,078,392	06/20/00	Thomas et al.	356	348	06/11/97
	C	2003/0048957 A1	03/13/03	Dai et al.	382	260	09/07/01
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FOREIGN PATENT DOCUMENTS							
		DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
	M						
	N						
	O						
	P						
	Q						
NON-PATENT DOCUMENTS							
		DOCUMENT (Including Author, Title, Source, and Pertinent Pages)					DATE
	P	U.S. Patent Application Serial No. 09/949,423 entitled <i>System and Method for Registering Complex Images</i> filed by X. Long Dai, et al. on September 7, 2001. 25 Pages.					09/07/01
	Q						
	R						
	S						
	T						
EXAMINER					DATE CONSIDERED		
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.							

PTO-1449

**Information Disclosure Citation
in an Application**

Application No.

Applicant(s)

Not yet assigned

Clarence E. Thomas, et al.

Docket Number

Group Art Unit

Filing Date

068062.0168

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September 12, 2003

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FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
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NON-PATENT DOCUMENTS

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
P	U.S. Patent Application Serial No. 09/949,423 entitled <i>System and Method for Registering Complex Images</i> filed by X. Long Dai, et al. on September 7, 2001. 25 Pages.	09/07/01
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EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.